

**Remarks/Arguments:**

**I. Status**

The Office Action dated June 30, 2006 (the “Office Action”) has been carefully reviewed. Claims 1, 2, 4, and 6-7 have been amended. Accordingly, claims 1-27 are pending in this application. Reconsideration of this application, as amended, is respectfully requested.

**II. The Rejection of Claims 1, 21-22 and 25 under 102(e)**

In the Office Action, claims 1, 21-22 and 25 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,333,692 B1 to Andersen et al. (hereinafter “Andersen”). Andersen does not disclose each element of claim 1 as amended.

*Discussion Regarding the Patentability of Claim 1*

1. Claim 1

Claim 1 recites:

A method of operating a self-service checkout terminal during a sales transaction comprising the steps of:  
allowing consumer scanning of an item for purchase via a scanner;  
detecting, after successfully scanning the item, an active electronic article surveillance tag associated with the item; and  
allowing deactivation of the active electronic article surveillance tag by the consumer via an active electronic article surveillance tag deactivator after detecting that the item has an electronic article surveillance tag, wherein the allowing consumer scanning, detecting and allowing deactivation are performed during a single sales transaction.

Thus, claim 1, as amended recites a method in which a self-service checkout terminal is controlled such that a customer is allowed to deactivate an electronic article surveillance (EAS) tag after an item has been “successfully” scanned and an active EAS tag associated with the article has been detected.

2. Andersen Does Not Disclose Customer Deactivation After Detection

Andersen determines whether or not an EAS is on an article by checking a database. More specifically, after an item is scanned, the UPC code for the item is used to search a database stored in memory to determine if the article should or should not be deactivated. (Andersen at column 5, lines 44-53). Thus, prior to being presented to the deactivator, the system of Andersen does not detect the EAS itself. Rather, the UPC code is detected.

Claim 1 has been amended to recite that the EAS tag associated with an item is “detected.” The UPC code of Andersen is not an EAS tag, and the EAS tag of Andersen is not detected. Therefore, Andersen does not disclose “detecting, after successfully scanning the item, an active electronic article surveillance tag associated with the item” and then allowing the deactivation of the scanned item.

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Accordingly, because claim 1 recites steps of detecting, after successfully scanning the item, an active electronic article surveillance tag associated with the item” and Andersen does not disclose any such method, the Applicants submit that the rejection of claim 1 has been overcome.

3. Andersen's Deactivator Does Not Allow Customer Deactivation

Additionally, while Andersen is not clear in identifying how "deactivations" are counted, it appears that some process of "detection" occurs when the deactivator is used. (See, e.g., Andersen at column 9, lines 19-23, "when no tag is detected within a predetermined number of seconds"). Neither the sequence of detection/activation nor the mechanism by which the detection occurs is clear. What is clear, however, is that the deactivation is performed automatically in conjunction with the deactivation of the EAS tag. Therefore, a customer is not "allowed" to deactivate the tag as required by the claim.

4. Conclusion

Because claim 1 recites steps of detecting, after successfully scanning the item, an active electronic article surveillance tag associated with the item" and Andersen does not disclose any such method, the Applicants submit that the rejection of claim 1 has been overcome.

*Discussion Regarding the Patentability of Claim 21*

1. Claim 21

Claim 21 recites:

A method of operating a checkout terminal comprising:  
scanning an item with a scanner;  
determining that the scanned item has an electronic article surveillance tag;  
allowing, after the step of determining, deactivation of the electronic article; and  
disabling the scanner from scanning other items based upon the step of determining.

Thus, claim 21 recites a method wherein in determination that a first item has an EAS tag disables the scanning of *other* items. The Applicants' specification identifies a

“scanner” as a device that is used, for example, to read a UPC code. (See, e.g., Applicants’ specification at page 10, lines 13-19). Thus, as used in the Applicants’ specification and in claim 21, “scanning” an item refers to the entry into the system of the identification of a specific item that is being purchased. Therefore, claim 21 recites that a determination that a first item has an EAS tag disables the entry into the system of the identification of other items.

## 2. Andersen Does Not Disclose Disabling as Claimed

The Examiner has alleged that Andersen discloses the disabling of scanning at column 9, lines 24-34. (Office Action at page 3). Respectfully, Andersen does not disclose disabling a scanner as recited in claim 21.

At column 9, lines 24-34 Andersen discloses a Scan Inhibit function that is used for the *same item* that has been scanned. More specifically, Andersen uses the word “scan” to describe two distinct operations. Andersen describes identifying an item through obtaining the item’s UPC code as “scanning”. (See, e.g., Andersen at column 7, lines 18-20). Andersen also uses the word “scanning” to identify the passing of an EAS tag through a deactivator. (See, e.g., Andersen at column 7, lines 19-23). The “Scan Inhibit” function is used to control the second type of operations, the activation/deactivation of the EAS deactivator. (Andersen at column 9, lines 24-27). Thus, Andersen discloses scanning an item to obtain a UPC code (identifying) and searching a database to determine whether or not the identified item should be subjected to the potentially deleterious effects of a deactivator. (Andersen at column 9, lines 29-30). If the identified item is sensitive to a deactivator, e.g., “magnetic tapes, film and

other merchandise that should not be scanned through the deactivator" (Andersen at column 7, lines 23-26), then the deactivator is deactivated by the Scan Inhibit function. (Andersen at column 9, lines 35-38).

Therefore, the "Scan Inhibit" function of Andersen relates to the energization/deenergization of the *deactivator* for the *identified* item. In contrast, claim 21 includes the limitation that a determination that an identified item has an EAS tag disables the identification of *other* items. Selective energization of a deactivator based upon the nature of the item identified by the system is not the same as inhibiting the identification of additional items once an item with an EAS tag is identified. Thus, Andersen does not disclose "disabling the scanner from scanning other items based upon the step of determining."

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Accordingly, because claim 21 recites "disabling the scanner from scanning other items based upon the step of determining" and Andersen does not disclose any such method, the Applicants respectfully submit that the rejection of claim 21 should be withdrawn.

#### *Discussion Regarding the Patentability of Claims 22 and 25*

Claims 22 and 25 also stand rejected as allegedly being anticipated by Andersen. Claims 22 and 25 depend from and incorporate all of the limitations of claim 1. Claims 22 and 25 further recite additional limitations. Accordingly, for at least the same reasons as those set forth above in connection with claim 21, it is respectfully submitted that claims 22 and 25 are patentable over the prior art.

### **III. The Rejection of Claims 1-20 under 103(a)**

In the Office Action, claims 2-3, 8-9, 13-16, 20 and 23 were rejected under 35 U.S.C. 103(a) as being obvious over Andersen in view of U.S. Patent no. 5,341,125 A to Plonsky et al. (hereinafter “Plonsky”), claims 4-7 and 24 were rejected under 35 U.S.C. 103(a) as being obvious over Andersen in view of U.S. Patent No. 6,598,791 B2 to Bellis, Jr. et al. (hereinafter “Bellis”), claims 10-12 and 17-19 were rejected as being obvious over Andersen in view of Plonsky and Bellis, claim 26 was rejected over Andersen in view of U.S. Patent No. 5,469,142 to Bergman et al. (hereinafter “Bergman”), and claim 27 was rejected over Andersen in view of Bellis in further view of Bergman. Respectfully, claims 2-4, 7-20, 23-24 and 26-27 are patentable over the cited art.

#### *Discussion Regarding the Patentability of Claims 2-3*

##### **1. The Discussion of Claim 1 Applies**

As an initial matter, Claims 2 and 3 depend from claim 1 and include all of the limitations of claim 1. The Examiner has rejected claims 2-3 based primarily upon Andersen with reliance on Plonsky for teaching an EAS detector. (Office Action at pages 5-6). Accordingly, the proposed modification fails to correct the deficiencies of Andersen discussed above with respect to the elements of claim 1. Therefore, a *prima facie* case of obviousness has not been presented with respect to claims 2-3. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 2-3.

2. There is No Motivation for the Proposed Modification.

Moreover, the Examiner has proposed the use of Plonsky's EAS detector "in lieu of performing a look-up PLU process." (Office Action at page 6). The motivation for the proposed modification is to "enhance the system accuracy and reduce time consumption." (Office Action at page 6). Respectfully, there is no motivation for the proposed modification.

The system of Andersen is directed toward resolving a problem of "easily and accurately [ascertaining] whether each of [the] products which should have been tagged in fact were." (Andersen at page 2, lines 15-17). Accordingly, the system of Andersen uses "a UPC code, or SKU, which is stored in a database either on the PC based POS 100 or at in-store processor 30... for correlating or identifying an item scanned as a tagged item which, therefore, should be properly deactivated by the deactivating unit 300." (Andersen at column 5, lines 10-15). Therefore, the accuracy of the system of Andersen *depends* upon the reading of the PLU code so as to determine is an article is properly tagged. The omission of the PLU lookup eviscerates the ability of the system of Andersen to compare the UPC count with the number of deactivations. (See, e.g., Andersen at column 6, line 5 through column 7, line 44).

Another problem corrected by the system of Andersen is the identification of sensitive items prior to exposing those items to a degaussing field. (Andersen at column 2, lines 36-38). The PLU lookup is used to ensure that sensitive media is not subjected to transmitted energy. (See, e.g., Andersen at column 5, line 42 through column 6, line 5).

The omission of the PLU lookup eviscerates the ability of the system of Andersen to identify sensitive items prior to application of external energy.

As the BPAI stated in the BPAI Decision on the Applicants' prior appeal, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (BPAI Decision at page 5, citing to *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Accordingly, because there is no teaching or suggestion to one skilled in the art to modify Andersen with Plonsky, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claims 2 and 3.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 2 and 3.

### 3. The Examiner's Line of Reasoning is Not Convincing

Moreover, the Examiner has not explained how the replacement of a PLU lookup system with the detector/deactivator of Plonsky would achieve a reduction in “time consumption” or why “time reduction” would be a benefit. (Office Action at page 6). Therefore, the line of reasoning for the proposed modification is not clear.

To the extent the Examiner intended to infer that the system of Andersen delayed the checkout procedure in performing the PLU lookup function, the Examiner's attention is respectfully directed to Andersen at column 9, lines 27-34. There, Andersen discloses the local storage of the PLU codes for sensitive data so as to avoid any timing issues. Thus, the system of Andersen does not suffer from a defect that a reduction in time consumption would address.

Therefore, the line of reasoning proposed by the Examiner does not make sense. Accordingly, the reasoning is not convincing. Because the Examiner has failed to provide a convincing line of reasoning as required by MPEP § 2144, citing to *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985), the Examiner has failed to provide a *prima facie* case of obviousness and the Examiner is respectfully requested to withdraw the rejection of claims 2 and 3.

#### 4. Conclusion as to Claims 2 and 3

Therefore, for any of the above reasons, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 2 and 3.

#### *Discussion Regarding the Patentability of Claims 8-9, 13-16 and 20*

The Examiner has also acknowledged that Andersen fails to teach, suggest or disclose all of the limitations found in claims 8-9, 13-16 and 20. (Office Action at page 5). The Examiner has relied upon Plonsky as disclosing the limitations lacking in Andersen based upon the same motivation discussed above with respect to claims 2 and 3. Therefore, because there is no motivation to modify Andersen as proposed by the Examiner for the reasons discussed above with respect to claims 2 and 3, the Applicants respectfully submit that claims 8-9, 13-16 and 20 are patentable over the prior art.

*Discussion Regarding the Patentability of Claim 23*

1. The Discussion of Claim 21 Applies

As an initial matter, Claim 23 depends from claim 21 and includes all of the limitations of claim 21. The Examiner has rejected claim 23 based primarily upon Andersen with reliance on Plonsky for teaching an EAS detector. (Office Action at pages 5-6). Accordingly, the proposed modification fails to correct the deficiencies of Andersen discussed above with respect to the elements of claim 21. Therefore, a *prima facie* case of obviousness has not been presented with respect to claim 23. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 23.

2. There is No Motivation for the Proposed Modification

Moreover, the Examiner has also acknowledged that Andersen fails to teach, suggest or disclose all of the limitations added by claim 23. (Office Action at page 5). The Examiner has relied upon Plonsky as disclosing the limitations lacking in Andersen based upon the same motivation discussed above with respect to claims 2 and 3. Therefore, because there is no motivation to modify Andersen as proposed by the Examiner for the reasons discussed above with respect to claims 2 and 3, the Applicants respectfully submit that claim 23 is patentable over the prior art.

3. Conclusion as to Claim 23

Therefore, for any of the above reasons, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 23.

*Discussion Regarding the Patentability of Claims 4-7*

1. The Discussion of Claim 1 Applies

As an initial matter, Claims 4-7 depend, either directly or through one or more intermediate claims, from claim 1 and include all of the limitations of claim 1. The Examiner has rejected claims 4-7 based primarily upon Andersen with reliance on Bellis for teaching an EAS detector in a bagwell. (Office Action at pages 5-6). Accordingly, the proposed modification fails to correct the deficiencies of Andersen discussed above with respect to the elements of claim 1. Therefore, a *prima facie* case of obviousness has not been presented with respect to claims 4-7. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 4-7.

2. There is No Motivation for the Proposed Modification.

Moreover, the Examiner has proposed the incorporation of an EAS detector in a bagwell as taught by Bellis. (Office Action at page 7). The motivation for the proposed modification is to ensure that all EAS tags are completely deactivated and to “prevent unscanned/unpaid items being bagged.” (Office Action at page 7). Respectfully, there is no motivation for the proposed modification.

Specifically, neither of the references identified by the Examiner provides any teaching, disclosure or suggestion for incorporating a “double check” on the system to ensure all tags are deactivated prior to the item leaving the store. As discussed above, the problem addressed by Andersen is the verification that items that should be tagged are in fact tagged. Bellis is directed toward the use of the weight of a group of items to verify

that the scanned items are the items placed onto a scale. (See, e.g., Bellis at column 2, lines 5-28).

Thus, not only are the references void of any mention of a double-check of EAS tag deactivation, the disparity of problems addressed and the manner in which they are addressed by the references do not suggest any particular combination. Therefore, the only motivation for combining the references in the manner proposed by the Examiner could only come from the Applicants' disclosure. Accordingly, because there is no teaching or suggestion to one skilled in the art to modify Andersen with Bellis other than the Applicants' disclosure, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claims 4-7. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 4-7.

### 3. Conclusion as to Claims 4-7

Therefore, for any of the above reasons, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 4-7.

#### *Discussion Regarding the Patentability of Claim 24*

##### 1. The Discussion of Claim 23 Applies

As an initial matter, Claim 24 depends from claim 23 and includes all of the limitations of claim 23. The Examiner has rejected claim 24 based primarily upon Andersen and Plonsky with reliance on Bellis for teaching an EAS detector in a bagwell. (Office Action at page 7). Accordingly, the proposed modification fails to correct the

deficiencies of Andersen and Plonsky discussed above with respect to the elements of claim 23. Therefore, a *prima facie* case of obviousness has not been presented with respect to claim 24. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 24.

**2. There is No Motivation for the Proposed Modification**

Moreover, the Examiner has also acknowledged that Andersen and Plonsky fail to teach, suggest or disclose all of the limitations added by claim 24. (Office Action at page 6). The Examiner has relied upon Bellis as disclosing the limitations lacking in Andersen based upon the same motivation discussed above with respect to claims 4-7. Therefore, because there is no motivation to modify Andersen as proposed by the Examiner for the reasons discussed above with respect to claims 4-7, the Applicants respectfully submit that claim 24 is patentable over the prior art.

**3. Conclusion as to Claim 24**

Therefore, for any of the above reasons, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 24.

*Discussion Regarding the Patentability of Claims 10-12 and 17-20*

**1. The Argument of Claims 8 and 15 Apply**

Claims 10-12 depend from claim 8 and include all of the limitations of claim 8. Claims 17-19 depend from claim 15 and include all of the limitations of claim 15. The

Examiner has also acknowledged that Andersen fails to teach, suggest or disclose all of the limitations found in claims 8 and 15. (Office Action at page 5). The Examiner has relied upon Plonsky as disclosing the limitations lacking in Andersen based upon the same motivation discussed above with respect to claims 2 and 3. Therefore, because there is no motivation to modify Andersen as proposed by the Examiner for the reasons discussed above with respect to claims 2 and 3, the Applicants respectfully submit that claims 10-12 and 17-19 are patentable over the prior art.

2. The Argument of Claims 4-7 Applies

Moreover, the Examiner has also acknowledged that the combination of Andersen and Plonsky fails to teach, suggest or disclose all of the limitations added by claims 10-12 and 17-19. (Office Action at page 7). The Examiner has relied upon Bellis as disclosing the limitations lacking in Andersen and Plonsky based upon the same motivation discussed above with respect to claims 4-7. Therefore, because there is no motivation to modify Andersen and Plonsky as proposed by the Examiner for the reasons discussed above with respect to claims 4-7, the Applicants respectfully submit that claims 10-12 and 17-19 are patentable over the prior art.

3. Conclusion as to Claims 10-12 and 17-19

Therefore, for any of the above reasons, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 10-12 and 17-19.

*Discussion Regarding the Patentability of Claim 26*

Claim 26 depends from claim 21 and includes all of the limitations of claim 21. The Examiner has rejected claim 26 based primarily upon Andersen with reliance on Bergman for teaching the indication of a need for intervention. (Office Action at page 9).<sup>1</sup> Accordingly, the proposed modification fails to correct the deficiencies of Andersen discussed above with respect to the elements of claim 21. Therefore, a *prima facie* case of obviousness has not been presented with respect to claim 26. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 26.

*Discussion Regarding the Patentability of Claim 27*

1. The Discussion of Claim 21 Applies

As an initial matter, Claim 27 depends from claim 21 and includes all of the limitations of claim 21. The Examiner has rejected claim 27 based primarily upon Andersen with reliance on Bellis for teaching an EAS detector in a bagwell. (Office Action at page 10). Accordingly, the proposed modification fails to correct the deficiencies of Andersen discussed above with respect to the elements of claim 21. Therefore, a *prima facie* case of obviousness has not been presented with respect to claim 27. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 27.

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<sup>1</sup> The discussion on page 9 of the Office Action identifies the rejected claim as claim 27. The limitation discussed, however, is the limitation introduced by claim 26. Moreover, the Office Action includes another rejection clearly directed to claim 27 at page 10. Therefore, the Applicants understand the reference to claim 27 on page 9 to be a typographical error.

2. There is No Motivation for the Proposed Modification

Moreover, the Examiner has also acknowledged that Andersen fails to teach, suggest or disclose all of the limitations added by claim 27. (Office Action at page 10). The Examiner has relied upon Bellis as disclosing the limitations lacking in Andersen based upon the same motivation discussed above with respect to claims 4-7. Therefore, because there is no motivation to modify Andersen as proposed by the Examiner for the reasons discussed above with respect to claims 4-7, the Applicants respectfully submit that claim 27 is patentable over the prior art.

3. Conclusion as to Claim 27

Therefore, for any of the above reasons, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 27.

3. Conclusion as to Claim 26

Therefore, for any of the above reasons, the Examiner has failed to provide a *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 26.

**IV. Conclusion**

Applicants respectfully request entry of the amendments and favorable consideration of the application.

A prompt and favorable action on the merits is requested.

Respectfully submitted,  
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